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PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
PAUL CHEN, et al.) : Examiner: G. Araque Jr.
Application No.: 10/000,468) : Group Art Unit: 3629
Filed: December 4, 2001) :
For: INTERNET PRINTING BY)
HOTEL GUESTS : April 20, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the restriction requirement dated February 21, 2006, the period for response to which having been extended to April 21, 2006 by the accompanying Petition For Extension Of Time with fee, Applicants provisionally elect to prosecute the Group I claims, namely Claims 1 to 40. The restriction requirement is, however, traversed.

One ground of traversal is that the restriction is simply facially defective. Specifically, the Office Action asserts that the two groups are related processes under MPEP 806.05(j). The Office Action cites three criteria listed under MPEP 806.05(j) for determining whether restriction is appropriate. As stated at MPEP 806.05(j), "the inventions are distinct if: (A) the inventions *as claimed* do not overlap in scope, i.e. are mutually exclusive; (B) the inventions *as claimed* are not obvious variants; and (C) the

inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01". Thus, it is abundantly clear from the "and" conjunction, that all three criteria must be met, and it is the Examiner's burden to establish all three criteria. The Office Action, however, only addresses (C) and fails to set forth any reasons to show that criteria (A) and (B) are also met. Therefore, the Office Action is simply facially defective.

Moreover, MPEP 806.05(j) states that, to "support a requirement for restriction between two or more ... related process inventions, both two-way distinctness and reasons for insisting on the restriction are necessary, i.e., separate classification, status in the art, or field of search. See MPEP § 808.02." In the Office Action, it is admitted that the Group I claims are classified in Class 705, subclass 1, and that the Group II claims (Claims 41 to 47) are also classified in Class 705, subclass 1. Despite the foregoing admission, the Office Action asserts that the two groups of claims "have acquired a separate status in the art because of their recognized divergent subject matter." It is simply not understandable how a different status in the art could actually be found since the claims are in the same classification, and therefore, the same field of search would apply. Thus, again, the Office Action is simply facially defective.

Turning to the substance of the claims, using Claims 1 and 41 as an example, the claimed invention is not directed to two distinct inventions. In fact, both claims include substantially similar subject matter that is merely claimed in a broader sense in Claim 1 than in Claim 41. Indeed, the Office Action fails to set forth a *prima facie* case of two-way distinctness as required by MPEP § 806.05(c). Nonetheless, Applicants submit

that both factors required for determining two-way distinctness simply cannot be met in this instance.

Finally, Applicants note there simply would not be an undue burden on the Examiner in examining both groups of claims in the same application. MPEP 808.02 requires that the Examiner show such an undue burden; but the Office Action fails to do so. The Office Action admits that the two groups are classified in the same class. Therefore, element (A) of MPEP 808.02 (i.e., separate classification) cannot be met. Element (B) of section 808.02 calls for a showing that, if the groups are classified together, that it must be shown that each invention was the subject of separate inventive effort. The Office Action apparently relies on this element in entering the restriction, but merely makes a bald assertion that the inventions have a separate status in the art. MPEP 808.02, however, requires that the Examiner cite, for example, patents which are evidence of such separate status, and also of a separate field of search. In this case, there simply is nothing in the Office Action to support a separate status; nor could there be since the claimed inventions are classified in the same class and subclass. Thus, there simply would not be an undue burden on the Examiner in examining both groups of claims in the same application.

In view of the foregoing, withdrawal of the restriction is respectfully requested and the Examiner is requested to rejoin Claims 41 to 47 and to issue an action on the merits for those claims.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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